EXHIBIT A

NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

IN RE EMC CORP., DECHO CORP., IOMEGA CORP., AND CARBONITE, INC.,
Petitioners.

Miscellaneous Docket No. 142

On Petition for Writ of Mandamus to the United States District Court for the Eastern District of Texas in case no. 10-CV-0435, Magistrate Judge Amos L. Mazzant.

ON PETITION

Before RADER, *Chief Judge*, DYK, and MOORE, *Circuit Judges*.

DYK, *Circuit Judge*.

O R D E R

This is petitioners EMC Corporation, Decho Corporation, Iomega Corporation and Carbonite Corporation's second request for a writ of mandamus in this case; as we noted before, this matter arose out of a single complaint filed by respondent Oasis Research LLC ("Oasis") charging a total of eighteen companies with offering online

backup and storage for home or business computer users that allegedly infringed its patents. *In re EMC Corp.*, 677 F.3d 1351 (Fed. Cir. 2012). The United States District Court for the Eastern District of Texas denied EMC and Carbonite's requests to sever the claims against them in separate motions filed shortly after the complaint. In its view, Rule 20 of the Federal Rules of Civil Procedure—which governs joinder of claims arising out of the same transaction or occurrence—was met because the defendants' accused services and products were "not dramatically different." *Oasis Research LLC v. ADrive LLC*, No. 4:10-CV-435, 2011 WL 3099885, at *2 (E.D. Tex. May 23, 2011). Given its conclusion that all eighteen claims belonged in the same action, the district court also denied EMC and Carbonite's motions to transfer venue to the United States District Courts for the Districts of Utah and Massachusetts, respectively, on the ground that transfer would divide a single action into several "different lawsuits scattered across the country." *Id.* at *4.

On petition this court reversed. We held that claims against independent defendants cannot be joined under the transaction-or-occurrence test "unless the facts underlying the claim of infringement asserted against each defendant share an aggregate of operative facts." *EMC*, 677 F.3d at 1359. Because application of the improper joinder test could preclude a proper transfer analysis and prevent the defendants from having a "meaningful opportunity to present individualized defenses on issues such as infringement, willfulness, and damages," we granted the petition to the limited extent that we directed the district court to apply the correct test. *Id.* at 1354-55. We did not express any opinion on the issue of transfer of venue.

After our opinion, the district court severed the matter into four separate cases, including creating a separate

action against Carbonite and a separate action against EMC, Decho, and Iomega, consolidated the cases for pre-trial proceedings, and again denied the petitioners' motions for transfer in separate orders. In its denial of transfer orders, the district court concluded that in each case the petitioners had failed to show that the transferee venues were clearly more convenient. In so finding, the district court acknowledged that at least one party in each case had maintained significant operations relating to an accused product in the transferee venues and that the petitioners had identified five potential witnesses who reside in Utah and two potential witnesses who reside in Massachusetts. However, the court concluded that the petitioners had not met their burden of demonstrating the need for transfer, particularly in light of the fact that some potential witnesses were located in or closer to the Eastern District of Texas, and several witnesses and sources of proof were located in various other states, including New York, Virginia, Colorado, and Washington, D.C. The district court, moreover, concluded in each case that judicial economy weighed heavily against transfer. In that regard, the district court noted that if it were to transfer the cases other courts "would have to spend significant resources to familiarize [themselves] with the patents, prosecution history, claim construction, and other issues in th[ese] case[s]." Taking particular issue with that analysis, the petitioners now seek a writ of mandamus with regard to those orders.

The petitioners' request for a writ directing the district court to transfer these cases runs up against a highly deferential standard of review. The question before us on mandamus is not whether the transferee venues are more convenient and fair; nor is it even whether in our view it was an abuse of discretion for the trial court to have denied transfer, which is the applicable standard of review on direct appeal. *See In re TS Tech USA Corp.*,

551 F.3d 1315, 1319 (Fed. Cir. 2008). Instead, the question is whether the denial of transfer was such a "'clear' abuse of discretion" that refusing transfer would produce a "patently erroneous result." *Id.* (quoting *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 310 (5th Cir. 2008) (en banc)). Under this highly deferential standard, we must leave the district court's decision undisturbed unless it is clear "that the facts and circumstances are without any basis for a judgment of discretion." *Volkswagen*, 545 F.3d at 317 n.7 (quoting *McGraw-Edison Co. v. Van Pelt*, 350 F.2d 361, 363 (8th Cir. 1965)). Here, we cannot say that standard has been met.

This case is a prime example of the importance of addressing motions to transfer at the outset of litigation. As the Fifth Circuit stated in *In re Horseshoe Entm't*, "in our view disposition of [a] motion [to transfer] should have taken a top priority in the handling of this case by the . . . District Court.[1]" 337 F.3d 429, 433 (5th Cir. 2003). Congress' intent "to prevent the waste of time, energy and money and to protect litigants, witnesses and the public against unnecessary inconvenience and expense," *Van Dusen v. Barrack*, 376 U.S. 612, 616 (1964) (internal quotation marks omitted), may be thwarted where, as here, defendants must partake in years of litigation prior to a determination on a transfer motion.

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[1] Similarly, the Third Circuit has concluded that "[j]udicial economy requires that [a] district court should not burden itself with the merits of the action until it is decided [whether] a transfer should be effected" and thus "it is not proper to postpone consideration of the application for transfer under § 1404(a) until discovery on the merits is completed." *McDonnell Douglas Corp. v. Polin*, 429 F.2d 30, 30 (3d Cir. 1970).

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